

REMARKS

This Amendment is submitted in reply to the non-final Office Action mailed on September 7, 2010. No fees are due herewith this Amendment. The Director is authorized to charge any fees that may be required, or to credit any overpayment to Deposit Account No. 02-1818. If such a withdrawal is made, please indicate the Attorney Docket No. 3712036-00751 on the account statement.

Claims 1-26 are pending in the application. Claims 11-25 were previously withdrawn. In the Office Action, Claims 1-10 and 26 are rejected under 35 U.S.C. §112. Claims 1-10 and 26 are rejected under 35 U.S.C. §103. In response, Claims 1 and 26 have been amended. The amendments do not add new matter and are supported in the specification at, for example, page 3, lines 14-30; page 6, lines 17-25; page 8, lines 18-28. In view of the amendments and/or for at least the reasons set forth below, Applicants respectfully request that the rejections be reconsidered and withdrawn.

In the Office Action, Claims 1-10 and 26 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Patent Office states that "Claims 1 and 26 recite[] the limitation 'the foam generating speed'" and that there exists insufficient antecedent basis for the limitation and that it is unclear what is meant by the phrase. See, Office Action, page 2, lines 18-23. Applicants respectfully traverse the indefiniteness rejections for at least the reasons set forth below.

The standard for determining whether the definitiveness requirement is met under 35 U.S.C. § 112, ¶ 2 is "whether those skilled in the art would understand what is claimed when the claim is read in light of the Specification." *Orthokinetics Inc. v. Safety Travel Chairs Inc.*, 1 U.S.P.Q. 2d 1081-1088 (Fed. Cir. 1986). "If the claims, read in light of the Specification, reasonably apprise those skilled in the art both of the utilization and scope of the invention, and if the language is as precise as the subject matter permits, the Courts can demand no more." *North American Vaccine Inc. v American Cyanamid Co.*, 28 U.S.P.Q. 2d 1333, 1339 (Fed. Cir. 1993). In this regard, "[p]atent law allows the inventor to be his own lexicographer ... [T]he specification aids in ascertaining the scope and meaning of the language employed in the claims inasmuch as words must be used in the same way in both the claims and the specification.

United States v. Teletronics, Inc., 8 U.S.P.Q. 2d 1217, 1220 (Fed. Cir. 1988). By statute, 35 U.S.C. 112, Congress has placed no limitations on how an applicant claims his invention, so long as the specification concludes with claims which particularly point out and distinctly claim that invention.” *In re Pilkington*, 162 U.S.P.Q. 145, 148 (C.C.P.A. 1996).

In response, Applicants have amended independent Claims 1 and 26 recite, in part, commanding, via the control and command means, said heating means associated with said support to heat said quantity of alimentary liquid while commanding said driving means for said mechanical stirring means at a first predetermined stirring speed, lower than a second predetermined stirring speed for stirring said quantity of alimentary liquid, and c) commanding, via the control and command means said mechanical stirring means for stirring said quantity of liquid at the second predetermined stirring speed, which is effective to make said liquid foam. The amendments do not add new matter and are supported in the specification at, for example, page 3, lines 14-30; page 6, lines 17-25; page 8, lines 18-28. As such, Applicants respectfully submit that the skilled artisan would immediately appreciate the scope of the present claims when read in view of the specification.

For at least the above-mentioned reasons, Applicants respectfully submit that Claims 1-10 and 26 fully comply with the requirements under 35 U.S.C. §112, second paragraph.

Accordingly, Applicants respectfully request that the rejection of Claims 1-10 and 26 under 35 U.S.C. §112, second paragraph, be reconsidered and withdrawn.

In the Office Action, Claims 1-4 are rejected under 35 U.S.C. §103(a) as being unpatentable over Viennese NPL (“*Viennese*”) in view of DE 10223444 to Guenou (“*Guenou*”) and U.S. Publication No. 2002/0130137 to Greenwald (“*Greenwald*”). Applicants respectfully submit that the cited references are deficient with respect to the present claims.

Currently amended independent Claim 1 recites, in part, commanding, via the control and command means, said heating means associated with said support to heat said quantity of alimentary liquid to a predetermined temperature while commanding said driving means for said mechanical stirring means at a first predetermined stirring speed, lower than a second predetermined stirring speed for stirring said quantity of alimentary liquid, and commanding, via the control and command means, said mechanical stirring means for stirring said quantity of liquid at the second predetermined stirring speed, which is effective to make said liquid foam.

The amendments do not add new matter and are supported in the specification at, for example, page 6, lines 4-25. The methods of the present claims advantageously enable form to be prepared quickly (i.e., within a few seconds only) from a determined quantity of liquid using a mechanical stirring device of simple and economical construction that does not use steam. Thus, the methods eliminate the drawbacks of the prior art devices with respect to the production of steam. Since the device for implementing the presently claimed methods can be made separately from a coffee machine, it is possible to prepare the coffee and the foam simultaneously. See, specification, page 3, lines 4-9.

Additionally, the present method claims require the use of a control and command means that may be used to advantageously control both the change of rotational direction of the rotating stirring means and the frequency of the changes. This is achieved by pre-programming a microcontroller with a program that is capable of running various stirring and heating programs depending on a desired container capacity. See, specification, page 4, line 36-page 5, line 12. Indeed, the specification states that "control means 24 comprise a microcontroller connected to motor 18 and to the heating element, and suitably programmed for controlling one or more foam producing cycles as a function of the quantity of liquid to be foamed." See, specification, page 7, lines 13-31. Stirring at a relatively low speed homogenizes the temperature of the milk in the container, preventing layers of different temperatures from forming and in particular, the lowest layer from burning and sticking to the bottom of the container, while activating the desired temperature increase. See, specification, page 8, lines 18-28. In contrast, Applicants respectfully submit that the cited references fail to disclose or suggest each and every element of the present claims.

Viennese, *Guenou* and *Greenwald* fail to disclose or suggest commanding, via the control and command means, said heating means associated with said support to heat said quantity of alimentary liquid to a predetermined temperature while commanding said driving means for said mechanical stirring means at a first predetermined stirring speed, lower than a second predetermined stirring speed for stirring said quantity of alimentary liquid, and commanding, via the control and command means, said mechanical stirring means for stirring said quantity of liquid at the second predetermined stirring speed, which is effective to make said liquid foam, as required, in part, by independent Claim 1. Instead, *Viennese* is entirely directed to methods for

making Viennese coffee by adding certain ingredients during certain steps. See, *Viennese*. The Patent Office even admits that *Viennese* fails to disclose or suggest heating while stirring. See, Office Action, page 7, line 11. In addition to failing to disclose or suggest heating while stirring, and as discussed above, *Viennese* also fails to disclose or suggest heating the alimentary liquid to a predetermined temperature while stirring, or stirring a liquid using stirring means, or commanding a device using control and command means, as required, in part, by independent Claim 1.

Guenou is entirely directed to a food stirrer that uses controls to set the stirrer speed and the heating plate temperature. See, *Guenou*, Abstract. As shown by Figure 3, however, the "controls" of *Guenou* are manual controls that may be set by a user to control the stirrer speed and heating plate temperature. See, *Guenou*, Figure 3. At no place in the disclosure, however, does *Guenou* disclose or suggest any of heating the alimentary liquid to a predetermined temperature while stirring, or stirring a liquid using stirring means, or commanding a device using control and command means, as required, in part, by independent Claim 1.

Greenwald is entirely directed to using a controller to set a position of a valve to mix both hot and cold coffee to dispense a final coffee product at a desired and predetermined temperature. See, *Greenwald*, Abstract; page 6, paragraphs 76-90. At no place in the disclosure, however, does *Greenwald* disclose or suggest any of heating the alimentary liquid to a predetermined temperature while stirring, or stirring a liquid using stirring means, or commanding a device using control and command means, as required, in part, by independent Claim 1. As such, Applicants respectfully submit that the cited references fail to disclose or suggest each and every element of the present claims.

Further, Applicants also respectfully submit that if the Patent Office could combine references to arrive at the present claims simply because each reference suggests an element of the present claims, then every invention would effectively be rendered obvious. For example, the mere fact that *Viennese* discloses the stirring and beating ingredients, *Guenou* discloses a device for stirring and heating a mixture, and *Greenwald* discloses a controller for controlling the dispensing temperature of a coffee, does not mean that the recognition of a method involving providing controlling the heating and stirring speed using a specific control means is necessarily *prima facie* obvious. Indeed, the controller of *Greenwald* is not even configured to control

heating and stirring as is required, in part, by the present claims, and the device of *Guenou* is simply a standard mixer. Instead, the skilled artisan must have a reason to combine the cited references to arrive at the present claims. Applicants respectfully submit that such a reason is not present in any combination of *Viennese*, *Guenou* and *Greenwald*.

Applicants also respectfully submit that the skilled artisan would have no reason to modify *Viennese* with *Guenou* and *Greenwald* to arrive at the present claims. For example, and as discussed above, the present claims are directed to methods of preparing foam from a milk-based liquid that enable form to be prepared quickly (i.e., within a few seconds only) from a determined quantity of liquid using a mechanical stirring device of simple and economical construction that does not use steam. Thus, the methods eliminate the drawbacks of the prior art devices with respect to the production of steam. Since the device for implementing the presently claimed methods can be made separately from a coffee machine, it is possible to prepare the coffee and the foam simultaneously. See, specification, page 3, lines 4-9. In contrast, *Viennese* merely discloses the steps and ingredients for producing Viennese coffee and does not even suggest specific devices or means for producing the coffee, let alone specific temperatures or the stirring means of the present claims. Further, the controller of *Greenwald* is not even configured to control heating and stirring as is required, in part, by the present claims, and the device of *Guenou* is simply a standard mixer. As such, Applicants respectfully submit that the inventive leap required by the skilled artisan to modify *Viennese* with *Guenou* and *Greenwald* to arrive at the present claims is tenuous, at best.

For at least the above-mentioned reasons, Applicants respectfully submit that the cited references are deficient with respect to the present claims.

Accordingly, Applicants respectfully request that the obviousness rejections of Claims 1-4 be reconsidered and withdrawn.

In the Office Action, Claims 5-7 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Viennese* in view of *Guenou*, *Greenwald* and U.S. Patent No. 6,283,625 to Frankel ("*Frankel*"). Claims 8-10 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Viennese* in view of *Guenou*, *Greenwald*, *Frankel*, U.S. Patent No. 4,537,332 to Brown ("*Brown*") and U.S. Patent No. 5,374,444 to Langer ("*Langer*"). Applicants respectfully submit that the patentability of Claim 1 as previously discussed renders moot the obviousness rejection

of Claims 5-10 that depend from Claim 1. In this regard, the cited art fails to teach or suggest the elements of Claims 5-10 in combination with the novel elements of Claim 1.

For at least the above-mentioned reasons, Applicants respectfully submit that the cited references are deficient with respect to the present claims.

Accordingly, Applicants respectfully request that the obviousness rejections of Claims 5-10 be reconsidered and withdrawn.

In the Office Action, Claim 26 is rejected under 35 U.S.C. §103(a) as being unpatentable over *Viennese*. Applicants respectfully submit that *Viennese* is deficient with respect to the present claims.

Currently amended independent Claim 26 recites, in part, heating the alimentary liquid to a predetermined temperature while stirring the liquid with stirring means at a first predetermined stirring speed, lower than a second predetermined stirring speed for stirring said quantity of alimentary liquid, and stirring said liquid with stirring means at the second predetermined stirring speed, which is effective to make said liquid foam. The amendments do not add new matter and are supported in the specification at, for example, page 6, lines 4-25. The methods of the present claims advantageously enable form to be prepared quickly (i.e., within a few seconds only) from a determined quantity of liquid using a mechanical stirring device of simple and economical construction that does not use steam. Thus, the methods eliminate the drawbacks of the prior art devices with respect to the production of steam. Since the device for implementing the presently claimed methods can be made separately from a coffee machine, it is possible to prepare the coffee and the foam simultaneously. See, specification, page 3, lines 4-9.

The stirring means of the present claims include, for example, mechanical stirring means of the rotating type and including a rod provided, at its distal end, a stirring head that extends in proximity to the bottom of a container. Stirring a liquid using such stirring means, and at a relatively low speed, homogenizes the temperature of the milk in the container, preventing layers of different temperatures from forming and in particular, the lowest layer from burning and sticking to the bottom of the container, while activating the desired temperature increase. See, specification, page 6, lines 17-25; page 8, lines 18-28. In contrast, Applicants respectfully submit that *Viennese* fails to disclose or suggest each and every element of the present claims.

Viennese fails to disclose or suggest heating the alimentary liquid to a predetermined temperature while stirring the liquid with stirring means at a first predetermined stirring speed, lower than a second predetermined stirring speed for stirring said quantity of alimentary liquid, and stirring said liquid with stirring means at the second predetermined stirring speed, which is effective to make said liquid foam, as required, in part, by independent Claim 26. Instead, *Viennese* is entirely directed to methods for making Viennese coffee by adding certain ingredients during certain steps. See, *Viennese*. At no place in the disclosure, however, does *Viennese* disclose or suggest heating the alimentary liquid to a predetermined temperature while stirring the liquid with stirring means at a first predetermined stirring speed. The Patent Office even admits that *Viennese* fails to disclose or suggest heating while stirring. See, Office Action, page 7, line 11. In addition to failing to disclose or suggest heating while stirring, and as discussed above, *Viennese* also fails to disclose or suggest heating the alimentary liquid to a predetermined temperature, or stirring a liquid using stirring means as required, in part, by independent Claim 26. As such, Applicants respectfully submit that *Viennese* fails to disclose or suggest each and every element of independent Claim 26.

Applicants also respectfully submit that the skilled artisan would have no reason to modify *Viennese* to arrive at the present claims. For example, and as discussed above, the present claims are directed to methods of preparing foam from a milk-based liquid that enable form to be prepared quickly (i.e., within a few seconds only) from a determined quantity of liquid using a mechanical stirring device of simple and economical construction that does not use steam. Thus, the methods eliminate the drawbacks of the prior art devices with respect to the production of steam. Since the device for implementing the presently claimed methods can be made separately from a coffee machine, it is possible to prepare the coffee and the foam simultaneously. See, specification, page 3, lines 4-9. In contrast, *Viennese* merely discloses the steps and ingredients for producing Viennese coffee and does not even suggest specific devices or means for producing the coffee, let alone specific temperatures or the stirring means of the present claims. As such, Applicants respectfully submit that the inventive leap required by the skilled artisan to modify *Viennese* to arrive at the present claims is tenuous, at best.

For at least the above-mentioned reasons, Applicants respectfully submit that *Viennese* is deficient with respect to the present claims.

Accordingly, Applicants respectfully request that the obviousness rejection of Claim 26 be reconsidered and withdrawn.

For the foregoing reasons, Applicants respectfully request reconsideration of the above-identified patent application and earnestly request an early allowance of the same. In the event there remains any impediment to allowance of the claims which could be clarified in a telephonic interview, the Examiner is respectfully requested to initiate such an interview with the undersigned.

Respectfully submitted,

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